



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,968	01/28/2002	Diana L. Kosinski	103864.129US1	8431
28089	7590	10/20/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			BLECK, CAROLYN M	
399 PARK AVENUE			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	

3626

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,968

Applicant(s)

KOSINSKI ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12, 28, 38, 40, 46, 58, 60, 64-69 and 74 is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-27, 29-37, 39, 41-45, 47-57, 59, 61-63 and 70-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 August 2004 has been entered.
2. This action is in response to the RCE filed 2 August 2004. Claims 1-74 are pending. Claims 1, 18, 37, 38, and 69 have been amended. Claims 70-74 are newly added.

Specification

3. The new matter objection under 35 § U.S.C. 132 is hereby withdrawn due to the response filed 2 August 2004.

Claim Objections

4. The objection of claim 46 is hereby withdrawn due to the response filed 2 August 2004.

Art Unit: 3626

5. Claims 1, 37, and 38, "said personnel comprising a non-physician user electronically signing a patient's orders resulting form said independently assessing" appears to be grammatically incorrect. Correction is requested.
6. Claims 19 and 74 recite "inpatient" which appears to be grammatically incorrect. Correction is requested.

Claim Rejections - 35 USC § 112

7. The rejection of claim 18 under 35 U.S.C. § 112, 2nd paragraph, is hereby withdrawn due to the amendment filed 2 August 2004.
8. The rejection of claims 65 and 67-69 under 35 U.S.C. § 112, 1st paragraph, is hereby withdrawn due to the amendment filed 2 August 2004.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 41 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Reese (6,711,460).

Art Unit: 3626

(A) As per claim 41, Reese discloses a pharmaceutical method for preparing prescriptions comprising:

(a) initiating a transaction by connecting to a remotely located pharmacist computer (Fig. 1 and 14, col. 7 lines 24-39, col. 15 lines 1-17, col. 16 lines 15-62) (remotely located pharmacist computer reads on "remotely located prescription processing system");

(b) transmitting an audio file, either in analog or digital, to the remote pharmacist (col. 15 lines 48-64); and

(c) delivering to the patient a filled prescription from an individual pharmacy determined by the pharmacist, wherein the individual pharmacy is remotely located (Fig. 1, col. 17 line 22 to col. 18 line 63, col. 23 lines 30-40).

(B) As per claim 61, Reese discloses a pharmaceutical method for preparing prescriptions comprising:

(a) initiating a connection to a technician at a service desk via telephone (col. 5 lines 13-24);

(b) transmitting the prescription request via the telephone to the technician (col. 5 lines 13-24 and col. 15 lines 49-63); and

(c) delivering to the patient a filled prescription from an individual pharmacy determined by the pharmacist, wherein the individual pharmacy is remotely located (Fig. 1, col. 17 line 22 to col. 18 line 63, col. 23 lines 30-40).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-8, 13-27, 29-37, 39, 42-45, 47-57, 59, and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese (6,711,460) in view of Haitin et al. (6,636,780) and Walker et al. (5,883,370).

(A) As per claim 1, Reese discloses a pharmaceutical method for preparing prescriptions comprising:

(a) initiating a transaction by connecting to a remotely located pharmacist computer (Fig. 1 and 14, col. 7 lines 24-39, col. 15 lines 1-17, col. 16 lines 15-62) (remotely located pharmacist computer reads on "remotely located prescription processing system");

(b) transmitting data corresponding to a prescription electronically to a pharmacist located remotely (Fig. 1 and 14, col. 23 lines 30-41);

(c) verifying by the remote pharmacist whether or not there are facial errors in the prescription which might prevent it from being filled, wherein facial errors are those apparent from the face of the prescription, wherein this kind of error includes a prescription missing information that is required by law, a prescription which orders an amount of medication that does not match the instructions for using it, one that is

Art Unit: 3626

missing a prescriber's name, or one that appears to have been tampered with, wherein if there are facial errors in the prescription, the remote pharmacist follows the pharmacy or state mandated policy and/or organizational policy to correct those errors or to reject the prescription or order (Fig. 14, col. 16 line 65 to col. 17 line 37);

(d) entering data from the prescription into an electronic form by the remote pharmacist (col. 15 lines 1-17) (It is noted in Reese discloses a technician performing this step. However, if the technician is not permitted to perform this step, then the remote pharmacist does);

(e) transmitting electronically the prescription to individual pharmacies (see Fig. 1 numbers 96, 98, and 100) (col. 3 line 60 to col. 4 line 4, col. 23 lines 30-40); and

(f) preparing a prescription corresponding to the prescription request in the electronic form (col. 3 line 60 to col. 4 line 4, col. 23 lines 30-40).

Reese fails to expressly disclose a non-physician user electronically signing a patient's orders.

Haitin discloses an authorizing pharmacist putting an electronic signature on medication orders (col. 6 lines 17-32, col. 9 line 64 to col. 10 line 15).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Haitin within the method of Reese with the motivation of increasing the quality of patient care by verifying each prescription (Reese, col. 17 lines 1-22), and ensuring there is a record of which pharmacist verified the prescription.

In addition, Reese does not explicitly disclose sending a completed prescription form to a filling pharmacy.

Walker includes printing out a prescription slip (Fig. 6) with a prescription bar code which contains pertinent prescription information to enable filling of the prescription, taking the prescription slip to a pharmacist by the patient, and having the pharmacist fill the prescription by scanning the prescription bar code on the prescription slip to obtain the pertinent information (Figure 3, col. 5 line 55 to col. 6 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned components of Walker with the method of Reese and Haitin with the motivation of reducing the number of errors in prescribing medications (Walker; col. 1 lines 25-30).

(B) As per claim 2, Reese discloses transmitting an audio file, either in analog or digital, to the remote pharmacist (col. 15 lines 48-64).

(C) As per claim 3, Reese discloses transmitting a facsimile to the remote pharmacist (col. 15 lines 17-38).

(D) As per claims 4-6, Reese, Haitin, and Walker fail to expressly disclose submitting the prescription request via electronic mail, wireless/ mobile device, and a PDA.

However, Reese discloses submitting a prescription by telephone, facsimile, and keypad (col. 14 line 14 to col. 15 line 64).

It is respectfully submitted that using electronic mail, wireless/ mobile device, and a PDA are all obvious variants of the telephone, facsimile, and a keypad, and therefore would have been obvious modifications within the method taught collectively by Reese, Haitin, and Walker with the motivation of providing a less rigid system and increasing the ease of use and thus user friendliness.

(E) As per claims 7-8, Reese discloses scanning the prescription for transcription purposes and transcribing the scanned prescription request (col. 14 line 65 to col. 15 line 17).

(F) As per claims 13-14 and 26-27, Reese discloses alerting a user that a prescription is ready to be inputted (col. 14 lines 30-37), inputting patient history and prescription information (Fig. 1, col. 5 lines 54-65) (patient history is considered to include "user information and member ID number"), verifying information input by the user (col. 16 line 65 to col. 17 line 37), and preparing a form for facsimile with the prescription information, image file, and data file and sending the form via facsimile (col. 15 lines 17-38). While there is no explicit recitation of a "unique identifier," Reese discloses creating a file of prescription information and an image file. The motivation for using a "unique identifier" being to track the prescription.

(G) As per claims 15-23, Reese discloses determining if the prescription request is to renew an existing prescription or to submit a new prescription (col. 14 lines 58-65, col.

Art Unit: 3626

16 lines 30-62, col. 20 lines 35-40), submitting member information, submitting patient information, and submitting medication information (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40), wherein member information includes the member's name and the member's address (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40), determining if there is an existing unique prescription number for renewal and requesting the existing unique prescription number if it is available (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40), determining if there is a change in patient therapy that would affect one or more aspects of the prescription request, and if there is no change in patient therapy, then performing the steps of reviewing the submitted prescription request to obtain the user's approval, and closing the prescription request (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 16 line 65 to col. 17 line 37, col. 20 lines 10-40), wherein the user does not approve the submitted prescription request based on the step of reviewing and further comprising a step of canceling the prescription request (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40), wherein there is a change in therapy, and further comprising the steps requesting new medication information from the user and reviewing the new medication information (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40), wherein there is no prescription number for renewal, and further comprising the steps of requesting member information, requesting patient information, and requesting medication information, and wherein the member information requested about the member includes the member's name and the

member's address (Fig. 1, col. 5 lines 54-65, col. 14 lines 58-65, col. 16 lines 30-62, col. 20 lines 35-40).

(H) As per claims 24-25, Reese discloses receiving a prescription from first and second customers at two remotely located pharmacies and repeating the steps of submitting, preparing, sending, and filling the prescriptions for the first and second users (col. 26 lines 5-22). As per the recitations of "closing the request" or "terminating the connection..," it is respectfully submitted that a system in which a customer uses, for example a website, would include the step of terminating a session or request when the user is finished using the system. The motivation being reducing the number of connections and time spent connect to a system, thus increasing security for a user utilizing the system.

(I) As per claim 29, Reese discloses using a telephone to submit a prescription using touch tone buttons on the telephone (col. 14 line 14 to col. 16 line 63).

(J) As per claims 30-31, Reese discloses establishing a direct connection over a network (col. 3 lines 20-39).

(K) As per claim 32, Reese fails to expressly disclose a packet-switched network. However, it is respectfully submitted that packet-switched networks are well known in

the art of networking. The motivation being for speed and efficiency of routing the packets along the best available route.

(L) As per claims 34-36, Reese discloses inputting patient history and prescription information (Fig. 1, col. 5 lines 54-65). It is respectfully submitted that patient history typically includes patient name, address, and date of birth. In addition, it is respectfully submitted that prescription information includes medication name, strength, and dosage.

(M) As per claims 54-55, Reese discloses submitted the prescription over the telephone by voice (col. 14 line 14 to col. 15 line 63).

(N) Claim 37 repeats the limitations of claims 1 and 7, and therefore is rejected for the same reasons given for those claims, and incorporated herein.

(O) Claim 39 repeats the limitations of claims 1, 7, and 25, and therefore is rejected for the same reasons given for those claims, and incorporated herein.

(P) Claim 42 repeats the same limitations as claims 1 and 2, and is therefore rejected for the same reasons as those claims, and incorporated herein.

Art Unit: 3626

(Q) Claims 56-57, 59, and 62 repeat the limitations of 1-2, 7, 25, 33, 39, and 54-55, are therefore rejected for the same reasons given for those claims, and incorporated herein.

(R) Claim 43 repeats the limitation of claim 1, and is therefore rejected for the same reasons as claim 1, and incorporated herein.

(S) Claims 44-45, 51-53, and 63 repeats the same limitations as claims 1-3, 29-30, 33, and 54-55, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(T) As per claims 47-49, Reese discloses using intranet (private network) or internet connections (public network) (col. 4 lines 5-22).

13. Claims 70-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese (6,711,460) in view of Walker et al. (5,883,370).

(A) As per claims 70-72, Reese discloses a system for preparing prescriptions comprising:

(a) a telephone for receiving an audible prescription request (col. 5 lines 13-24, col. 14 line 14 to col. 16 line 62);

(b) a computer for receiving a prescription request over a network (col. 3 lines 20-40, col. 14 line 14 to col. 16 line 62);

(c) a technician or pharmacist for retrieving information from a digitized prescription request (see an audio file) (col. 3 lines 20-40, col. 14 line 14 to col. 16 line 62);

(d) a database for storing prescription information from a digitized prescription request (col. 3 lines 20-40, col. 14 line 14 to col. 16 line 62); and

(e) a computer for verifying by the remote pharmacist whether or not there are facial errors in the prescription which might prevent it from being filled, wherein facial errors are those apparent from the face of the prescription, wherein this kind of error includes a prescription missing information that is required by law, a prescription which orders an amount of medication that does not match the instructions for using it, one that is missing a prescriber's name, or one that appears to have been tampered with, wherein if there are facial errors in the prescription, the remote pharmacist follows the pharmacy or state mandated policy and/or organizational policy to correct those errors or to reject the prescription or order (Fig. 14, col. 3 lines 20-40, col. 16 line 65 to col. 17 line 37).

Reese does not explicitly disclose sending a completed prescription form to a filling pharmacy.

Walker includes printing out a prescription slip (Fig. 6) with a prescription bar code which contains pertinent prescription information to enable filling of the prescription, taking the prescription slip to a pharmacist by the patient, and having the pharmacist fill the prescription by scanning the prescription bar code on the prescription slip to obtain the pertinent information (Figure 3, col. 5 line 55 to col. 6 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned components of Walker with the system of Reese and Haitin with the motivation of reducing the number of errors in prescribing medications (Walker; col. 1 lines 25-30).

(B) As per claim 73, Reese discloses a standard digitized audio format (Fig. 14, col. 3 lines 20-40, col. 16 line 65 to col. 17 line 37).

Allowable Subject Matter

14. Claims 9-12, 28, 38, 40, 46, 58, 60, 64-69, and 74 are allowed.

15. The following is an examiner's statement of reasons for allowance:

Claim 9 is directed towards converting the captured prescription request to a digitized format at the prescription processing system to obtain a digitized prescription request and storing the digitized prescription request on a database maintained by the prescription processing system.

The closest prior art of record, Albaum et al. (US 5,758,095) teaches an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Figs. 49e and 49f,

Art Unit: 3626

col. 7, lines 25-30, col. 11, lines 4-13, and col. 20, line 40, to col. 21, line 33). However, Albaum fails to teach a step of converting a prescription request and storing a digitized prescription request because in the method of Albaum, the request is already in a digitized format so no conversion is necessary.

Claims 10-12 incorporate the features of claim 9, and are allowed for the same reasons given above.

Claim 28 is directed towards the step of comparing, at the prescription processing system, a physician's phone number and a prescription number', and if the physician's phone number and the prescription number result in a predetermined relationship, wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system then filling the prescription request using an automated entry agent associated with the prescription processing system.

The closest prior art of record, Bartur (US 6,263,259), teaches verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract, col. 1, lines 30-50, and col. 13, line 49 to col. 14, line 44). Neither Albaum or Bartur disclose comparing, at the prescription processing system, a physician's phone number and a prescription number.

Claim 66 incorporates the features of claim 28, and is allowed for the same reasons given above.

Claims 38 and 40 are directed towards converting the captured prescription request to a digitized format, creating an identification file, including identification data, for the digitized prescription request, associating the identification file and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claims 38 and 40.

The closest prior art of record, Albaum et al. (US 5,758,095), teaches an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Figs. 49e and 49f, col. 7, lines 25-30, col. 11, lines 4-13, and col. 20, line 40, to col. 21, line 33). However, Albaum fails to teach a step of converting a prescription request and storing a digitized prescription request because in the method of Albaum, the request is already in a digitized format so no conversion is necessary. Thus, the prior art of record, namely Albaum et al. (5,758,095), Walker et al. (5,883,370), and Simcox (5,992,890), fail to teach the features of converting the captured prescription request to a digitized format,

Art Unit: 3626

creating an identification file, including identification data, for the digitized prescription request, associating the identification file and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claims 38 and 40.

Claims 46 recites wherein said prescription processing system includes a header entry agent for retrieving general information from a digitized prescription request, wherein said submitted prescription is digitized into said digitized prescription request, and transcribing said general information, wherein said general information comprises non-medication related information comprising at least one of member's name, member's identification number, physician information, and patient information.

The closest prior art of record, Johnson et al. (5,664,109), teaches extracting medically relevant information and demographic information using a batch extraction program from an OCR file and creating a new medical service record associated with the medically relevant information and demographic information and populating the data fields of a new medical service record with the extracted pre-defined data, wherein the file includes demographic information, such as a patient's name and social security number, medical prescriptions (Fig. 7, col. 6 line 44 to col. 7 line 57, col. 13 lines 1-27, col. 15 lines 5-20, col. 15 line 45 to col. 18 line 17). However, Johnson fails to teach a header entry agent for retrieving general information from a digitized prescription request at the prescription processing system.

Claims 58, 60, and 64-65 are directed towards converting the captured prescription request to a digitized format, creating an identification file, including identification data, for the digitized prescription request, associating the identification file and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claims 58, 60, 64-65.

The closest prior art of record, Albaum et al. (US 5,758,095), teaches an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Figs. 49e and 49f, col. 7, lines 25-30, col. 11, lines 4-13, and col. 20, line 40, to col. 21, line 33). However, Albaum fails to teach a step of converting a prescription request and storing a digitized prescription request because in the method of Albaum, the request is already in a digitized format so no conversion is necessary. Thus, the prior art of record, namely Albaum et al. (5,758,095), Walker et al. (5,883,370), Munoz et al. (US 2002/0052760), and Simcox (5,992,890), fail to teach the features of converting the captured prescription request to a digitized format, creating an identification file, including identification data, for the digitized prescription request, associating the identification file

and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claims 58, 60, and 64-65.

Claims 67-69 are directed towards converting the captured prescription request to a digitized format at the prescription processing system to obtain a digitized prescription request, storing the digitized prescription request on a database maintained by the prescription processing system, creating an identification file, including identification data, for the digitized prescription request, concatenating the identification file with the digitized prescription request to form a prescription file, comparing, at the prescription processing system, a physician's phone number and a prescription number, and if the physician's phone number and the prescription number result in a predetermined relationship, wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system, then filling the prescription request using an automated entry agent associated with the prescription processing system.

The closest prior art of record, Albaum et al. (US 5,758,095), teaches an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module

Art Unit: 3626

performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Figs. 49e and 49f, col. 7, lines 25-30, col. 11, lines 4-13, and col. 20, line 40, to col. 21, line 33). However, Albaum fails to teach a step of converting a prescription request and storing a digitized prescription request because in the method of Albaum, the request is already in a digitized format so no conversion is necessary. In addition, the closest prior art of record, Bartur (US 6,263,259), teaches verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract, col. 1, lines 30-50, and col. 13, line 49 to col. 14, line 44). Neither Albaum or Bartur disclose comparing, at the prescription processing system, a physician's phone number and a prescription number.

Thus, the prior art of record, namely Albaum et al. (5,758,095), Walker et al. (5,883,370), Munoz et al. (US 2002/0052760), Simcox (5,992,890), and Bartur (6,263,259), fail to teach the features of converting the captured prescription request to a digitized format at the prescription processing system to obtain a digitized prescription request, storing the digitized prescription request on a database maintained by the prescription processing system, creating an identification file, including identification data, for the digitized prescription request, concatenating the identification file with the digitized prescription request to form a prescription file, comparing, at the prescription processing system, a physician's phone number and a prescription number, and if the physician's phone number and the prescription number result in a predetermined

relationship, wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system, then filling the prescription request using an automated entry agent associated with the prescription processing system, in combination with the additional features recited in claims 67-69.

Claim 74 is directed towards comparing, at the prescription processing system, a physician's phone number and a prescription number, if the physician's phone number and the prescription number result in a predetermined relationship, wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system, then filling the prescription request using an automated entry agent associated with the prescription processing system, converting the captured prescription request to a digitized format to obtain a digitized prescription request, creating an identification file, including identification data, for the digitized prescription request, associating the identification file and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claim 74.

The closest prior art of record, Albaum et al. (US 5,758,095), teaches an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order

information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Figs. 49e and 49f, col. 7, lines 25-30, col. 11, lines 4-13, and col. 20, line 40, to col. 21, line 33). However, Albaum fails to teach a step of converting a prescription request and storing a digitized prescription request because in the method of Albaum, the request is already in a digitized format so no conversion is necessary. In addition, the closest prior art of record, Bartur (US 6,263,259), teaches verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract, col. 1, lines 30-50, and col. 13, line 49 to col. 14, line 44). Neither Albaum or Bartur disclose comparing, at the prescription processing system, a physician's phone number and a prescription number.

Thus, the prior art of record, namely Albaum et al. (5,758,095), Walker et al. (5,883,370), Munoz et al. (US 2002/0052760), Simcox (5,992,890), and Bartur (6,263,259), fail to teach the features of comparing, at the prescription processing system, a physician's phone number and a prescription number, if the physician's phone number and the prescription number result in a predetermined relationship, wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system, then filling the

prescription request using an automated entry agent associated with the prescription processing system, converting the captured prescription request to a digitized format to obtain a digitized prescription request, creating an identification file, including identification data, for the digitized prescription request, associating the identification file and the digitized prescription request to form a prescription file, storing the prescription file on a database maintained by the prescription processing system, and transcribing the digitized prescription request, in combination with the additional features recited in claim 74.

Response to Arguments

16. Applicant's arguments with respect to claims 1-69 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches an apparatus and method for satisfying disposable contact lens prescriptions (4,958,280), remote prescription refill system (6,493,427 and 6,744,862), automatic prescription drug dispenser (6,529,801), RX Scan (Drug topics), Automation or central fill and central processing of prescriptions (Felkey), Central filling for pharmacies (Vavra), and Medco products and services (see website).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Art Unit: 3626

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB

CB

October 15, 2004

Joseph Thomas
JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600